

REMARKS:

This Preliminary Amendment responds to the examiner's latest rejection of the claims. The examiner indicates that he has withdrawn his rejection under 35 USC §103. The applicant appreciates the examiners action. The applicant will now address the rejection of the claims under 35 USC § 101 and 35 USC § 112.

In addition to the comments traversing the rejection of the claims under 35 USC § 101 in the Submission accompanying the Request for Continued Prosecution, which is incorporated herein by reference, the applicant would like to call to the examiners attention, the case of State Street Bank & Trust Company vs. Signature Financial Group Inc. 149 Fed. 3rd 1368. At head-note 6 of State Street, the court was clear on the interrelationship between the terms practical, useful, concrete and tangible. The court in commenting on the Diehr case, 450 US 175, said, "As in Diehr, the court [there] explained that certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application, i.e. "A useful, concrete and tangible result." Thus the court is quite clear that "practical" is the standard, and useful, concrete and tangible is just one way to satisfy the standard. Thus Board of Appeals in finding a useful, practical and tangible result has really found that standard of "practical" for the invention has been met. Thus applicant submits that the examiner's rejection of the claims under 35 USC § 101 is not consistent with the current law and should be withdrawn. Applicant respectfully requests such action.

On page 5 of applicant's Submission accompanying the Request for Continued Prosecution applicant responds to the examiners rejection under 35 USC § 112, those responses are incorporated herein. In addition, the applicant has the following comments and submits an

Affidavit under Rule 132, establishing the level of competence of applicant's peers (those skilled in the art) at the time of the invention in late 1995.

Specifically, the specification itself clearly instructs one skilled in the art on how to proceed to practice the claimed invention. On page 5 at line 13, the instruction is given "The inventive method comprises the steps of interacting with a computer which is generally pre-programmed....the memory is programmed such that the data is organized by predetermined risk factors." In January of 1996, one skilled in the art would quickly recognize that this step can be accomplished by using an Excel spreadsheet, see Affidavit line 13, and listing in columns the risk factors, selection of which is specific to the Intellectual Property in question. With respect to a product protected by a patent it is taught on page 11, at line 16 "...information concerning the product maybe highly relevant, for example, perhaps the product uses scarce raw materials. 'One would conclude that scarce raw materials would be an impediment to large volume production and larger royalties. 'Similarly, the need for highly skilled labor would reduce the potential for large royalties and again would be a consideration in determining the relative risk. 'Also considerations such as any resulting toxic or pollutant materials as a by-product may be again a deterrent to going into production and therefore lessens the chances of a large monetary gain." Thus, applicant has clearly instructed that one skilled in the art to consider those applicable risk factors from the list of 100 set forth and compile them using an Excel spreadsheet.

Having thus established the risk factors by considering those which are relevant to the product in question as instructed above, data is entered from a questionnaire (see lines 3 through 7 of the Affidavit) concerning the Intellectual Property or from the results of a series of completed tasks which tasks are set forth on pages 27 & 28, and from other sources which sources are specifically

set forth in columnar form in Figure 1. The computer will sort the data entered and place it in the column under the risk factor heading to which it applies. The risk factors are then weighted, and, as taught on page 7, lines 12 through 14, the weight given to each is derived from estimates or actual experience gained through a test marketing program.

In late 1995 one skilled in the art one would recognize that to weight a risk factor one must compare it to some standard. The Applicant clearly instructs how to determine that standard on page 8 at lines 11 et. seq. "The process of determining the standard...can be accomplished by applying actual experience factors to calculate the standard. 'Compiling this experience data enables one to establish a norm or an average....'Then an individual patent risk factor...is compared to this average and the relative [weighted] risk factor is obtained." The Affidavit further elucidates the method for determining standards and weight factors known at the time of the invention.

The Applicants instructions are clear and unambiguous 1.) Look at the Intellectual Property to be evaluated, and identify the characteristics of the product defined and claimed. Select from the risk factors presented those which appear relevant (page 11, line 16 et. seq.) 2.) Estimate a relative value for each risk factor, selected-or if available use values from a questionnaire (page 5 line 15 et. seq.). This second step would have been easily accomplished by one skilled in the art in late 1995, simply by selecting a range of values for a example: from 1 to 5 or from 1 to 10 and assigning a number by estimation to that particular risk factor (see Affidavit lines 4 et. seq.). 3.) Continue adding estimated or experimentally determined values for each of the risk factors until a table is constructed from which a mean is derived, which then allows one to compare the mean to the risk factor in question thereby resulting in a weighted (relative) risk factor.

The idea of assigning values to investigated criteria and creating a table are not new concepts since persons routinely apply numbers to written concepts to evaluate them. This technique is used in all aspects of both physical as well as social sciences. Individual behaviors, answers to essay questions, effects of treatments are just a few of the literally hundreds of thousands of situations where numbers are used to quantify and evaluate ideas, results, concepts and assessments. This capability in late 1995 was inherent in any person operating a computer with an Excel spreadsheet.

The Applicant has repeatedly indicated that the inventive method comprises the steps of interacting with a computer which is generally preprogrammed....page 5 lines 13 through 15.

Thus the question need not be asked, nor does the Applicant have to teach how to program a computer. It is well known that a patent disclosure need not enable information within the knowledge of an ordinary skilled artisan, thus a patent preferably omits from the disclosure any routine technology that is well known at the time of the application. See *Hybritech, Inc., v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1384(Fed cir 1986).

Moreover, with respect to the question of undue experimentation, the court in the *Re Wands* made it quite clear that: “The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed....” *IN RE WANDS* 858F.2d731, 737 (FED CIR. 1988).


Also while it is required that the Applicant must enable one of ordinary skill in the art to practice the invention, in *AK Steel Corp. v. Sollac* the court held “That is not to say that the specification itself must necessarily describe how to make and use every possible variant of the claimed

invention, for the artisans knowledge of the prior art and routine experimentation can often fill the gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending on the predictability of the art. *AK Steel Corp. v. Sollac* 344F.3d1234,1244 (Fed cir 2003).

Also the objection has been raised that...“it is unclear from applicants disclosure to what [sic] is considered low and what is considered high probable success factor. ‘There is no indication in the specification of how the composite score is used to evaluate the strength of an specific Intellectual Property, nor how the probable success factor is used in undertaking a lawsuit, the actual step of evaluating the strength of an Intellectual Property using the score is not performed.’” In commenting on the invention during a preceding Appeal to the Board of Appeals, the Board stated that “The calculation of a score for determining the probability of success of undertaking commercialization of an Intellectual Property is clearly a tangible use for a practical result which is attained in the instant claimed invention.” This statement by the Board leads to the inescapable conclusion that a low score simply means below or less than average and a high probable success factor alternatively means greater than or above average and intuitively one selects a high probable success factor in deciding whether or not to undertake a lawsuit.

Having addressed the examiners previously submitted bases for rejection of the claims, Applicant respectfully requests this application be allowed and passed to issue.

Respectfully,



Robert W. Fletcher

RULE 132 AFFIDAVIT:

I, Mr. Steve Hardin of 2821 S. Hourstbourne Parkway, Suite 1, Louisville, Kentucky 40220, am experienced in collecting data and computer technology. I have previously structured questionnaires which collected data to be used in various analyses. My technique has been to assign a range of values for each answer in a questionnaire. The act of assigning from a range of values, a specific value to a specific answer in the questionnaire is rational. Next a table of values is created for each question reciting the number given from the range to each specific answer of each specific question in the questionnaire. The average is computed for each question in the questionnaire and a mean is calculated. Relative weights are known to be assigned to the number value of each answer to each question in the questionnaire. Once the weights have been calculated the answers to each questionnaire represent a composite value which can be compared to the norm for purposes of determining specific results in a numeric fashion. These types of investigations and analysis were common place in late 1995, generally through pre-programmed computers using for example an Excel Spreadsheet. Such analyses do not require undue experimentation for their performance nor did they in late 1995.

Moreover, I am aware that willful false statements are punishable under various state and federal laws including 18 USC § 1008.

Further, Affiant sayeth not.



Steve Hardin
Cambridge Business Solutions, Inc.

4/4/05
Date